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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,865	12/21/2001	Gerald Delgorgue	P21708	5631
7055	7590	09/21/2004		
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
			EXAMINER STASHICK, ANTHONY D	
			ART UNIT 3728	PAPER NUMBER

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/023,865	<b>Applicant(s)</b> GERALD DELGOURGUE ET AL.	
	<b>Examiner</b> Anthony Stashick	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

DETAILED ACTION

*Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-8, 11-13, 21 and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kogert et al. 3,570,149. Kogert et al. '149 discloses all the limitations substantially as claimed including the following: assembling an upper on the sole (see col. 1, lines 54-60); applying at least one layer of flexible or semi-rigid polymer in a liquid state in predetermined areas of the upper (see col. 2, lines 7-11); the predetermined areas are less than an entirety of the upper (where necessary, in line 9-10 of col. 2, can be any portion of the upper); drying the article of footwear (col. 2, lines 7-11, multiple layers can only be applied if the preceding layer has dried, otherwise not separate layers); applying the polymer with a brush (see painting in col. 2, lines 12-13 and 22-24); applying the polymer by spraying (see col. 2, lines 12-13 and 20-24); liquefying the polymer by heating (col. 2, line 41); the polymer is made of polyurethane (col. 2, line 41); the upper comprises mesh material (textile material includes mesh material); upper comprises three-dimensional mesh material (multiple layers makes it three dimensional with a length, width and thickness); the material of the upper being aeratable (see col. 2, line 2, porous is aeratable). Kogert teaches that the outer coating material can be polyurethane. Applicant, in claim 7 of the instant application, admits that all the materials claimed in claims 27-33 are equivalents of polyurethane, at least in the properties desired for

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application to waterproof a shoe. Therefore, since the material of claims 27-33 are accepted equivalents of the polyurethane used by Kogert '149, Kogert '149 would anticipate the use of these materials.

With respect to the diluting of the material, Kogert '149 teaches that different areas of the boot upper can be coated with polyurethane of different porosities. Since a layer of different porosity of polyurethane would require the dilution of the polyurethane with another material, especially in the spraying and painting areas where a liquid would be needed, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to dilute the polyurethane to whatever degree necessary to give the desired porosity of the material for the given portions of the boot.

3. Claims 4, 9-10, 16-20, 24-26 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kogert et al, 3,570,149 as applied above in view of FR Lentz 720,292 (Lentz '292). Kogert '149 discloses all the limitations of the claims substantially as claimed except for the polymer layer straddling the sole and upper, the polymer layer varying in height along the length of the upper, the polymer layer raising in height along the rear of the upper. Lentz '292 teaches that a layer applied to the external side of a shoe can cover the shoe sole and upper with the layer varying in height along the upper from the front to the heel of the shoe (see Figure 3). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the external layer of protective material vary in height from the front to the heel of the shoe while covering the sole and upper, as taught by Lentz '292, to the shoe of Kogert

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'149, to prevent entrance of fluid into the shoe between the upper and sole as well as to give added support to the user's foot when placed within the shoe.

4. Claims 14, 15, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 13 and 21 above in view of Burt 6,401,364. The references as applied to claims 13 and 21 above disclose all the limitations of the claims except for the aeratable material being made of a pair of spaced-apart layers of mesh fabric and a fibrous layer located between them with an air space. Burt '364 teaches that the breathable upper of a shoe can be made of an internal mesh layer 40 and an external mesh layer 20 (see col. 4, lines 35-60) with a reinforcing layer located in between. The reference states "the internal layer 40 is made of a three-dimensional mesh which is more comfortable to the wearer than mesh. The three-dimensional mesh is a loose configuration of fibers 42 extending substantially perpendicularly between a soft porous inner layer 41 and an outer porous layer 43, which provide a porous layer that allows gases, such as air, and liquids, such as perspiration, to travel ...". Therefore, Burt '364 teaches that the upper of a shoe can be made of a three-dimensional mesh layer with fibrous material (and air) located between the internal and external layers. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the upper of the Kogert '149, out of the material suggested by Burt '364 to allow for a light and breathable upper to be reinforced and still be light in weight.

***Response to Arguments***

5. Applicant's arguments filed June 14, 2004 have been fully considered but they are not persuasive. Applicant argues that the instant application is patentable over the prior art used and is not obvious in view of Kogert. Applicant argues that Kogert requires that the entirety of the upper be coated and that the rejection is based upon this section of Kogert. This argument is not clearly understood. Applicant's attention is respectfully directed to the rejection where it states that where required and for certain fields of use, a plurality of layers of compact porous polyurethane can be applied, "where necessary" having varying porosity, hardness, toughness, etc. This can be found in Kogert in col. 2, lines 7-11. This meets applicant's limitation of "applying at least one layer of the flexible or semi-rigid liquid polymer in predetermined areas of the upper, said predetermined areas constituting less than an entirety of the upper." in the claim. Nowhere in the claim does it state that the upper is breathable before or after the application of the liquid polymer. It appears that applicant is arguing more than that which is claimed as the claims, not the disclosure, define the invention. Therefore, less than the entirety of the upper is coated. The teaching of this can be found in column 2, lines 7-11. Applicant further ascertains that it is not clear where the language "where necessary" is located in Kogert, as noted above, it is located in col. 2, lines 7-11 as cited in this and the previous rejection. Applicant further argues that it is not clear whether Kogert applies the polyurethane in a liquid state. This argument is not clear. As stated in column lines 20-24, the coating can be applied by "injection molding, spraying, dipping or painting". As is known in the art, dipping, spraying and painting are typically done with the material in a liquid state. Therefore, Kogert would teach this as well by using these known techniques. Applicant's remarks with regard to the combination of Kogert

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and Lentz are also not clearly understood. Applicant argues that Lentz does not teach a layer straddling the upper and the sole. This argument is not clearly understood. Lentz clearly teaches a layer straddling both the upper and the sole for the purpose of preventing ingress of material between the shoe sole and the upper. This would teach Kogert that at least this portion of the upper and sole should be layered with polyurethane as one of the “necessary” portions.

Applicant further argues that Kogert does not teach drying the article of footwear. This was addressed in the rejection that multiple layers cannot be applied until the previous layer is dried, otherwise they would not be separate layers. Applicant argues that mesh material is not taught by Kogert, because textile material is not necessarily a mesh material. This argument is not clearly understood. There are textile materials that are mesh and therefore, these materials would meet the limitations of the claim. The textile materials in Kogert are not limited to those textile materials that are not mesh. Kogert encompasses all textile materials, even those that are mesh or woven. Applicant further argues that Kogert does not disclose an aeratable material. This argument is also not clearly understood. Kogert uses a porous material in col. 2, line 2, and since it is porous, it is aeratable. It appears that applicant is arguing more than that which is claimed. Applicant appears to be arguing that the material is aeratable after the coating, a limitation not present in the claims. Since the material of Kogert is aeratable before coating, it meets the claimed limitation.

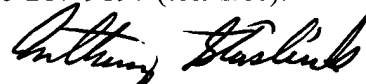
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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is (703) 308-3876. The examiner can normally be reached on Monday through Thursday from 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS